

Application No. 10/662,683  
Amendment dated May 30, 2006

Docket No.: 28076/SV1094

### REMARKS

Claims 11-19 were examined in the most recent final office action, dated March 27, 2006. Claims 33-43 were withdrawn as allegedly drawn to an independent and distinct invention. Claims 11-13 and 16-18 stand rejected as obvious over Sunaga, U.S. Patent No. 6,737,770 in view of Matsuoka et al, U.S. Patent No. 5,880,666. Claims 14, 15, and 19 stand rejected as obvious over Sunaga in view of Matsuoka and in further view of Lewchenko, U.S. Patent No. 6,058,595. Applicant respectfully requests withdrawal of the restriction requirement, and, as amended herein, applicant respectfully requests allowance of all claims.

#### The Restriction Requirement is Improper.

Applicant respectfully traverses the Office's restriction requirement, which alleges that three separate inventions are claimed, Group I, claims 11-19, Group II, claims 33-42, and Group III, claim 43.

The Office has not met its burden of proving that Group I is distinct from Group II. First, the Office alleges that Group I has "separate utility such as terminating the first magnet wire at the switch." However, Group II recites "connecting the connector portion of the first magnet wire... to a internal terminal on a switch." Accordingly, Group II recites a limitation similar to the alleged separate utility, and the Office has failed show that Group I has separate utility. Further, the electric motor of claim 11 and the electric motor of claim 33 can be used in the same applications. There has been no showing otherwise. Accordingly, there is no separate utility of the resulting electric motors.

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Furthermore, applicant traverses that Group I is a subcombination of the combination recited in Group II, as alleged by the Office. As stated in MPEP § 806.05(a), a combination is an organization of which a subcombination is a part. Here, there is no organization recited in claim 33 of which claim 11 is a part. Instead, both claims are directed to a method of making an electric motor, with slightly varying claim scope. Claim 11 does not recite a portion of a method of making an electric motor that could be used in making the motor of claim 33 as well as in making a motor different than that claimed in claim 33. The combination/sub-combination analysis is more properly reserved for situations such as separate claims to an automobile engine and a valve stem, because the valve stem could be used in other non-claimed automobile engines. Again, these are simply claims to a similar method of making an electric motor, with slightly varying scope.

Finally, the Office's method of determining separate utility is in error. Here, the Office simply recites a claim limitation of claim 11 and argues that because claim 33 does not recite that particular claim limitation, claim 11 has separate utility. This is in error because it does not prove that Group II cannot be used in the same manner, and therefore that Group I has separate utility. There is no showing that Group II could not have the first magnet wire terminated at the first switch, and, of course, it could.

The Office cannot simply point to a limitation of one claim and argue separate utility because another claim does not share that specific limitation. If the Office's standard were correct, every claim would be a distinct invention from every other claim, because all claims have different limitations. The question is not whether there are differing limitations, the question is whether Group II could be used in the same manner as Group I. Because the electric

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motor of Group II can be used in the same applications as the electric motor of Group I, and vice versa, the Office has not met its burden of showing separate utility of Group II.

Likewise, Group III is not distinct from Group I, because there has been no showing of separate utility. The Office alleges that the invention of Group III has separate utility from the invention of Group I such as exciting the first coil to rotate the armature. The separate utility alleged by the Office is in error, because both the inventions of Group I and Group III can perform the asserted function. While the invention of Group I does not specifically claim the alleged separate utility, it cannot be disputed that the electric motor described in Group I also has the utility of exciting the first coil to rotate the armature. This is the very nature of an electric motor. Accordingly, the Office has failed to show how the resulting electric motor of Group III has separate utility from the resulting electric motor of Group I. Withdrawal of the restriction requirement and substantive examination of the claims 33-43 is respectfully requested.

Claims 11-19 are Allowable.

As claim 11 is amended, applicant respectfully traverses the rejection to claim 11 as obvious over Sunaga in view of Matsuoka and vice versa. Claim 11 has been amended to recite, in part, connecting an end portion of the first magnet wire directly to the switch. Applicant has simply amended claim 11 to clarify the language of the method already recited. No new issues are presented, and no new search is required. Accordingly, the Office should enter this amendment after final rejection and substantively consider claim 11 for patentability.

Applicant understands the Office's broad interpretation of "terminated at" to read as "coupled to" (see Office Action, p. 8) and has amended claim 11 to address this issue. None of

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the cited references disclose or suggest connecting an end portion of the magnet wire directly to the switch. Sunaga discloses that the end portion of the exciting coil 7 is directly connected to a terminal pin 48. The terminal pin 48 is then directly connected to the printed wiring board 40. A switching device 41 is disposed on the printed wiring board 40 and is connected to the terminal pin 48 by way of conductive tracks on the board 40. The Office seems to agree that the Sunaga reference fails to suggest a direction connection. "Technically in a circuit board where an electronic device is coupled or terminated to another one, rarely are these devices piggy-backed to or directly/structurally touching each other..." Office action, p. 8. Neither Matsuoka nor Lewchenko add anything in this regard. Accordingly, claim 11 is allowable over the art of record. Dependent claims 12-19 are allowable for at least the same reasons.

Claims 33-43 are Allowable.

Both claims 33 and 43 recite, in part, connecting a connector portion of the first magnet wire to an input terminal on a switch. As outlined above, Sunaga fails to disclose or suggest that any portion of the magnet wire itself connected to a switch. In contrast, the magnet wire is connected to a pin, which is connected to circuit board, which includes conductive tracks that lead to a switching device. Accordingly, claims 33 and 43 are allowable over the art or record. Dependent claims 34-42 are allowable for at least the same reasons.

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**CONCLUSION**

In view of the above amendment, the pending application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

No fee is believed due at this time. However, if any fee is due, please charge our Deposit Account No. 13-2855, under Order No. 28076/SV1094 from which the undersigned is authorized to draw.

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Respectfully submitted,

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